AF 3700

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IN RE APPLICATION OF	:	Sullivan
FOR	:	**MULTI-LAYER GOLF BALL**
SERIAL NO.	:	08/815,556
FILED	:	March 12, 1997
EXAMINER	:	M. Graham
ART UNIT	:	3711
CUSTOMER NO.	:	24492
ATTORNEY DOCKET NO.	:	P-3724-f2 (SLDZ 200035-1-1)

November 3, 2003
Cleveland, Ohio 44114

Reply Brief Transmittal

Mail Stop Reply Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing in the above-identified application is Applicant's Reply Brief, in triplicate.

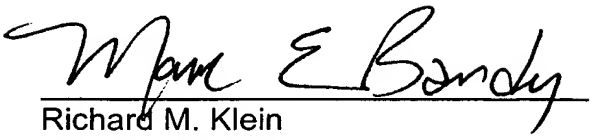
Please charge any fee deficiencies or credit any overpayment to Deposit Account No. 06-0308.

CERTIFICATE OF MAILING
I hereby certify that this correspondence and related papers are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Reply Brief-Patents Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 3, 2003.

By: Mary Ann Temesvari
Mary Ann Temesvari

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP



Richard M. Klein
Reg. No. 33,000
Mark E. Bandy
Reg. No. 35,788
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114-2579
(216) 861-5582

#42 Reply Brief hmoreja- 11/19/03

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF	:	Sullivan, Michael J.
FOR	:	**MULTI-LAYER GOLF BALL**
SERIAL NO.	:	08/815,556
FILED	:	March 12, 1997
ART UNIT	:	3711
EXAMINER	:	M. Graham
CUSTOMER NO.	:	24492
ATTORNEY DOCKET NO.	:	P-3724-F2 (SLD 2 035-1-1)

Cleveland, Ohio 44114-2518
October 27, 2003

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Mail Stop Reply Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer mailed October 3, 2003.

This Reply Brief addresses the Examiner's arguments presented under the headings "(10) Grounds of Rejection" and "(11) Response to Argument." Specifically, this Reply responds to the Examiner's views concerning the rejections at issue based upon certain prior art and the Examiner's interpretation of that art.

A. Background

Before addressing the arguments presented in the Examiner's Answer, it is instructive to first re-visit a decision in a previous appeal. That previous appeal involved an application that claimed priority from the present application.

In November of 2000, Appellant filed an Appeal Brief in U.S. application Serial No. 09/121,628. The '628 application was a continuation application of the present application. In that appeal, designated as Appeal No. 2001-1989, the Board sustained a rejection of claims under §103 based upon the same combinations of prior art as cited in the rejections at issue in this appeal. Specifically, the Board upheld a rejection under §103 based upon the '193 patent to Nesbitt and the '739 patent to Horiuchi et al. The Board additionally sustained a rejection under §103 based upon the '193 patent to Nesbitt in view of the '739 patent to Horiuchi et al. and the '814 patent to Sullivan.

However, as explained herein, it is Appellant's position that the previous decision was against established precedent by the Court of Appeals for the Federal Circuit, and thus, improper. Accordingly, any decision in the present appeal should be reached independently and without regard to that previous misplaced decision.

B. Rejection of Claims 1-5, 9-11, and 13 Must Be Reversed

Appellant now addresses the Examiner's arguments offered in the Examiner's Answer mailed October 3, 2003. Specifically, with regard to the rejection of claims 1-5, 9-11 and 13 under §103(a) over the '193 patent to Nesbitt in view of the '739 patent to Horiuchi et al., the Examiner contended:

> Just as in Appeal No. 2001-1989, wherein the instant rejection was affirmed by the Board of Appeals, appellant's argument is based on the premise that the teachings of a single cover layer ball, Horiuchi, cannot be combined with a two-cover layer ball as disclosed by Nesbitt. Again, however, the examiner has relied on Horiuchi to teach the benefits of high acid ionomers. Higher stiffness and higher impact resilience (resulting in better flying performance) is achieved when using ionomers of 16-30% acid. These are precisely the characteristics called for by Nesbitt for his inner layer (col. 1, lines 57-60). Nesbitt does not explicitly teach any acid level in his inner cover ionomer (although inherently 15% is used). One practicing Nesbitt's invention would select ionomers of high flex modulus (i.e. stiffness) and coefficient of restitution (impact resilience). The recently developed ionomers of 16-30% acid meet this criteria.
>
> It appears appellant is merely "updating" Nesbitt's inventive concept of stiff inner cover (for shot distance) and soft cover (for "feel") by replacing the older stiff ionomer with newer stiff ionomer. Only the expected improvements are obtained.

Pages 3-4 of Examiner's Answer.

No. Appellant is not arguing that the teachings of a single cover layer ball cannot be combined with a two layer ball. The Examiner mischaracterizes Appellant's position.

Appellant submits that the '739 patent to Horiuchi et al. teaches the use of ionomers having 16% to 30% by weight acid in a single outer cover layer. A designer looking to the teachings of the '739 patent to Horiuchi et al. would be motivated to utilize a single cover layer configuration. If someone did look to the '739 patent in designing a multi-layer cover golf ball, one would be motivated to use the high acid ionomer taught by Horiuchi et al. in an outer cover layer. This provides, among other things, improved scuff resistance and/or durability when the abrasive surface of the club face comes in contact with the outer surface or cover of a ball. There is absolutely no teaching in the '739 patent to Horiuchi to suggest that the benefits described therein are applicable or transferable to an inner cover layer or mantle or a multi-layer golf ball. Specifically, there is no teaching in Horiuchi et al. to suggest that the benefits achieved utilizing the high acid ionomer as an outer cover are obtainable when the high acid ionomer is utilized as an inner cover layer in combination with an outer cover layer comprising a soft polymeric ionomer. As a matter of fact, properties such as improved scuff resistance would have no benefit to the inner cover or mantle layer of a ball.

The '193 patent to Nesbitt teaches relatively low acid ionomers and would teach away from using high acid ionomers in an inner cover layer. The '739 patent to Horiuchi et al. discloses high acid ionomers in outer covers (of a single cover layer golf ball) and would additionally teach away from using high acid ionomers in an inner cover layer of a multi-layer golf ball. As a matter of fact, properties such as improved scuff resistance, etc., for an outer cover layer would have no benefit to the inner cover or mantle layer of a ball. Such properties are only beneficial to the outer cover layer of the ball.

Consequently, there is no motivation, other than through prohibited hindsight reconstruction in view of the claimed invention, to combine the '193 patent and the '739 patent to arrive at the claimed invention. The Examiner is basing his rejection on impermissible hindsight reconstruction (citations omitted). One may not

look to the prior art and selectively pick and choose from various passages to recreate the claimed invention. This is well established in the law (citations omitted).

Additionally, following the teaching of the '193 patent to Nesbitt, one would be motivated to use a relatively low acid ionomer such as Surlyn 1605 in the inner cover layer.[1] This is expressly noted in the '193 patent at col. 3, lines 26-29. This arrangement is opposite from that recited in the pending claims. The pending claims are directed to the use of a high acid ionomer in the inner cover layer.

Therefore, there is no motivation, other than through prohibited hindsight reconstruction in view of the claimed invention, to combine the '193 patent and the '739 patent to arrive at the claimed invention. The '193 patent to Nesbitt teaches relatively low acid ionomers and would teach away from using high acid ionomers in an inner cover layer. The '739 patent to Horiuchi et al. discloses high acid ionomers in outer covers (of a single cover layer golf ball) and would additionally teach away from using high acid ionomers in an inner cover layer of a multi-layer golf ball.

Additionally, the present rejection must be reversed because the Examiner based the rejection upon an incorrect view that all high acid ionomers exhibit the same physical properties. They do not.

The Examiner's blanket assertion that "(h)igher stiffness and higher impact resilience ... is achieved when using ionomers of 16-30% acid" is incorrect. Contrary to the Examiner's statement, there is no exact correlation here. The properties of low acid and high acid ionomers vary. See for example, Escor (Iotek) 960 (page 15, lines 8-16 of the application) which has a relatively high acid content of about 19-21% but a low cover hardness (i.e. Shore D 57) and flexural modulus value (i.e. 27,000 psi). These properties are suggestive of a low acid ionomer. Under the Examiner's view, all high acid ionomers should exhibit similar properties. The fact is, they do not.

Although Nesbitt notes that it is desirable to utilize a hard, high flexural modulus resinous material in an inner cover layer, the Examiner ignored the fact that Nesbitt teaches the use of a low acid ionomer in an inner cover layer. Furthermore, the Examiner incorrectly concluded that a suggestion to use a "hard, high flexural modulus material" necessarily means that a high acid ionomer be used. Numerous

[1] As correctly pointed out by the Examiner, Surlyn 1605 is an ionomer comprising 15% acid.

low acid ionomers are known that are hard and which exhibit high flexural modulus values. Furthermore, a wide array of non-ionomeric materials are known which are hard and that exhibit high flexural modulus values. Moreover, several high acid ionomers are not hard, etc.

The Examiner also contended "it appears appellant is merely updating Nesbitt's inventive concept of stiff inner cover (for shot distance) and soft outer cover (for "feel") by replacing the older stiff ionomer with newer stiff ionomer. Only the expected improvements are obtained."

This is entirely incorrect. Appellant takes issue with the Examiner's mischaracterization and degrading comments concerning the present invention. The pending claims recite specific unique features, the culmination of which resulted from extensive research and development efforts by the Assignee, Spalding Sports Worldwide, Inc. It is simply wrong to refer to the present invention as an "update" of Nesbitt's invention.

Accordingly, based upon the Examiner's mischaracterization of Appellant's reasons in support of patentability, hindsight reconstruction of the claimed subject matter, misreading of the prior art, and a technically incorrect assumption about the properties of ionomers, the present rejection must be reversed.

B. Rejection of Claims 6-8 and 12 Must Be Reversed

In the Examiner's Answer mailed October 3, 2003, the Examiner explained the grounds for the other rejection under §103(a) based upon the noted patents to Nesbitt and Horiuchi et al., in further view of the '814 patent to Sullivan et al.:

> With regard to appellant's argument "2," appellant merely repeats the argument advanced with regard to the Nesbitt/Horiuchi rejection and additionally argues that Sullivan is limited to two layer balls while Nesbitt is directed to three layer balls.
>
> Appellant fails to provide any reasoning why the advantages of Sullivan's hard/soft ionomer blend would not be expected to manifest themselves on a three layer ball such as the Nesbitt ball. Sullivan teaches an outer cover of a hard/soft ionomer blend results in a soft cover that a skilled golfer can impart backspin to (abstract). These are the qualities Nesbitt desires in his outer cover. It should be noted that the identical rejection of claim 12 in Appeal No. 2001-1989 was upheld by the Board of Appeals.

Page 4 of Examiner's Answer mailed October 3, 2003.

It is the Examiner who fails to provide any reasoning why he engages in the practice of picking and choosing selected passages in the cited patents and to ignore other passages. The Examiner should be aware that hindsight reconstruction is not permitted.

It is conceivable that if the cited art provided the requisite motivation to utilize a blend of hard/soft ionomers in an outer cover of a golf ball as in rejected claims 6-8 and 12, then the advantages associated with the use of that blend might be imparted to the resulting golf ball. However, rejecting the present claims on this particular ground is improper. The art relied upon still fails to teach the particular combination of materials and arrangement of layers as called for in the pending claims. The law requires rejection based upon teachings in the art and not what might be conceivable or mere speculation. The Examiner wholly failed to identify the specific teachings in the collection of patents that teach the claimed subject matter.

The Examiner also contended that the rejection of claim 12 is "identical" to that in the previous appeal. No. Claim 12 at issue in the previous appeal recited "an ionomeric outer cover." Claim 12 at issue in the present appeal does not recite the outer cover as "ionomeric." In further contrast, claim 12 in the present appeal recites the terpolymer as a terpolymer of a certain olefin, methacrylic or acrylic acid. Claim 12 in the previous appeal did not recite that the terpolymer could be based on methacrylic acid. Additionally, claim 12 in the former appeal recited any type of spherical core. In contrast, claim 12, currently at issue, recites that the core is solid. It is wrong and unfair to Appellant to state that the rejections of claim 12 in the previous appeal and the current appeal are "identical." They are not.

For at least these reasons, the Examiner's rejections must be reversed.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & MCKEE, LLP

Richard M. Klein
Reg. No. 33,000
Mark E. Bandy
Reg. No. 35,788
1100 Superior Avenue
Suite 700
Cleveland, OH 44114-2518
(216) 861-5582

N:\SLDZ\200035\3B\clc0098A.doc